

S.N. 10/796,814

Art Unit 1742

REMARKS:

Claims 1-3 are pending.

Citing the parent case (now U.S. Patent No. 5,591,317, hereinafter the '317 Patent) from which the present application derives its filing-date priority (as acknowledged on page 2, paragraph 1, of the current Office Action), the Examiner has rejected all claims under 35 U.S.C. 102(b).

In relevant part, 35 U.S.C. 102(b) reads:

A person shall be entitled to a patent unless...(b) the invention was patent or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States....

The applicant respectfully submits that the plain language of 35 U.S.C. 102(b) requires that anticipation be shown by a reference that is "more than one year prior to the date of application for a patent in the United States." Because the present application has the same filing date as the reference relied upon by the Examiner (again, the Examiner has acknowledged the priority benefit of the '317 Patent in the present case), this rejection is clearly erroneous.

No case law or other authority standing for the proposition that an applicant's parent application itself can be used to anticipate a child application was cited by the Examiner. In a telephone call with the Examiner after receiving the current Office Action, the applicant's attorney inquired about the basis for citing a parent case to which priority had been perfected as anticipating prior art. In response, the Examiner mentioned the possible applicability of MPEP 2133.01 ("Rejections of Continuation-in-Part (CIP) Application").

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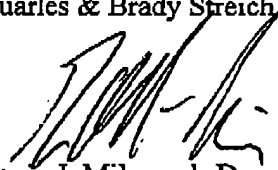
The applicant respectfully points out that the Examiner, despite having entered the priority benefit of the '317 Patent, has argued that all elements of pending claims 1-3 are found in the '317 Patent, thereby anticipating the present invention. In contrast, MPEP 2133.01 applies to situations in which the "applicant files a continuation-in-part whose claims are **not supported** by the parent application" (emphasis added). Accordingly, even if it were now the Examiner's position that claims 1-3 were not supported by the disclosure of the '317 Patent (in which case priority should not have been granted), the '317 Patent still cannot, by definition, anticipate the present application because a lack of supporting disclosure means that one or more elements of claims 1-3 must be missing from the '317 Patent.

In view of the foregoing, the applicant respectfully requests that the Examiner reconsider withdrawing all rejections and passing this case to allowance.

No fee is believed to be due with this response. Should there be any unforeseen costs, please charge our Deposit Account No. 17-0055.

Respectfully submitted,

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